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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,163	09/27/2001	Shridhar P. Joshi	47079-0117	3932

7590 12/24/2002

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EXAMINER

RADA, ALEX P

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/965,163	JOSHI, SHRIDHAR P.
	Examiner Alex P. Rada	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 01 October 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

In response to the amendment filed October 01, 2002 in which the applicant has amended claims 1, 14, and 18, and claims 1-26 are pending in this office action.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn '024.

3. Von Kohorn discloses a gaming machine including random selection of a game outcome, dispensing a tangible sweepstakes entry from the gaming machine in response to predetermined criteria, and submitting the sweepstakes entry to enter the sweepstakes without involving the gaming machine and conducting the sweepstakes after the sweepstakes entry is dispensed from the gaming machine as recited in claims 1 and 18 (column 154, line 11-38).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn '024 in view of Schneider '976.

Von Kohorn discloses the claimed invention as discussed above except for the predetermined criteria include the selected outcome being a predetermined one or more of the plurality of possible outcomes as recited in claims 2, 14-15, and 19; the possible outcomes are associated with a payout exceeding a predetermined threshold as recited in claims 3, 16, and 20; the predetermined criteria include the selected outcome being associated with a payout exceeding a predetermined threshold as recited in claims 4 and 21; a response to a predetermined outcome selected in the game as recited in claims 5 and 22; receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes as recited in claims 12 and 25. Schneider teaches a gaming machine having an outcome being a predetermined one or more of the plurality of possible outcomes, the possible outcomes are associated with a payout exceeding a predetermined threshold, the predetermined criteria include the selected outcome being associated with a payout exceeding a predetermined threshold, a response to a predetermined outcome selected in the game, and receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes. By having predetermined outcomes associated with a payout exceeding a threshold or predetermined criteria, one of ordinary skill in the art would be able to provide game players with different opportunities and chances to achieve a bigger payout. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Von Kohorn to include a gaming machine having an outcome being a predetermined one or more of the plurality of possible outcomes, the possible outcomes are associated with a payout exceeding a predetermined threshold, the predetermined criteria include the selected outcome being associated

with a payout exceeding a predetermined threshold, a response to a predetermined outcome selected in the game, and receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes as taught by Schneider. To do so would be able to have game players venture for a bigger prize.

Furthermore, for the purpose of the rejection of claims 6-11, 17 and 23-24, it would have been obvious to design a sweepstakes entry form made on pre-printed paper, filling out the needed information, and dropping off the entry or mailing the entry to determine an overall winner in a game. Lastly, for the purpose of the rejection of claims 13 and 26, it would have been obvious to have a group consisting of slots, poker, keno, bingo, and blackjack to enable a game player to choose a game to his or her liking.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kelly '344 discloses a prize redemption system for use with one or more game apparatuses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

*APR*  
apr  
December 19, 2002

*S. Thomas Hughes*  
S. THOMAS HUGHES  
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